



FISH & RICHARDSON  
225 FRANKLIN STREET  
BOSTON, MA 02110

**COPY MAILED**

**OCT 25 2005**

**OFFICE OF PETITIONS**

In re Application of	:	
Vinciarelli et al.	:	
Application No. 09/841,471	:	DECISION ON PETITION
Filed: April 24, 2001	:	
Attorney Docket No. 00614-120001	:	

This is a decision on the petition filed September 28, 2005, to withdraw the holding of abandonment, and in the alternative, a petition under 37 CFR 1.137(b) to revive the above-identified application.

On August 23, 2004, the Office mailed a Notice of Allowance and Fee(s) Due ("Notice of Allowance"), which set a three (3) month statutory period to pay the issue fee and the publication fee. The application became abandoned on November 24, 2004. A Notice of Abandonment was mailed on September 2, 2005.

#### **PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

On June 1, 2004, petitioners paid the issue fee and the publication fee in response to the First Notice of Allowance mailed on April 7, 2004. On July 16, 2004, petitioners filed a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. The petition was granted by the decision of July 26, 2004, which stated that the application was withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). Furthermore, petitioners were advised that the issue fee paid on June 1, 2004, could not be refunded; however, petitioners could request that it be applied to the issue fee required by a new Notice of Allowance, if the application was again allowed. The decision informed petitioners that the request to apply the issue fee to the new Notice of Allowance could be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b). Lastly, the decision advised petitioners that, whether or not the Notice of Allowance indicated that a fee was due, the Issue Fee Transmittal Form PTOL-85(b) **MUST** be completed and timely submitted to avoid abandonment. Moreover, the Second Notice of Allowance stated in bold language that the PTOL-85(b) (or an equivalent) **MUST** be returned within the period indicated, even if no fee is due, or the application will be regarded abandoned.

In the present petition, petitioners asserted that on September 22, 2005, they filed a response to the Second Notice of Allowance, which included comments on the reasons for allowance and a general authorization "to apply any charges or credits to our Deposit Account No. 06-1050." Petitioners admitted that they did not submit a completed form PTOL-85(b) with their response due to petitioners' error. Petitioners averred that their records showed that they did not believe a completed form PTOL-85(b) was necessary for responding to the Second Notice of Allowance. Petitioners explained that they believed that the mistake occurred because the Second Notice of Allowance did not indicate that an issue fee was due and the fact that they previously submitted the Issue Fee Transmittal Form PTOL-85(b) in response to the First Notice of Allowance. Petitioners further asserted that 35 U.S.C. 151 requires that the sum specified by the Notice of Allowance be paid within three months of the notice; however, the Second Notice of Allowance did not indicate that any issue fee or publication fee was due. Therefore, petitioners stated that their response did not run afoul of 35 U.S.C. 151.

Upon a review of petitioner's arguments and the office record, the showing of record is insufficient to warrant withdrawal of the holding of abandonment.

The Office notified petitioners in the First and Second Notices of Allowance and in the decision of July 26, 2004, that if the issue fee had already been paid and prosecution was reopened, petitioners could request a refund or request that the fee be credited to a deposit account. However, if the application was again allowed, upon receipt of a new Notice of Allowance, petitioners could request that the previously submitted issue fee be applied to the application by completing a new Issue Fee Transmittal Form PTOL-85(b).

As previously stated, petitioners did not believe a completed form PTOL-85(b) was necessary for responding to the Second Notice of Allowance because the Second Notice of Allowance did not indicate any issue fee or publication fee was due. The Office reminds petitioner of Section 1308 of the Manual for Patent Examining procedure which states: "[T]he Notice of Allowance will reflect an issue fee amount that is due that is the difference between the current issue fee amount and the issue fee that was previously paid." On the mail date of the Second Notice of Allowance, the amount due for the issue fee and the publication fee did not increase, and therefore, the Notice showed a difference owed of \$0.

In view of the above, the petition to withdraw the holding of abandonment is **dismissed**.

#### **PETITION UNDER 37 CFR 1.137(b)**

Petitioners have met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" be submitted. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioners must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

The Office notes that the issue fee increased from the mail date of the Second Notice of Allowance and the date petitioners paid the fee. The issue fee increased to \$1,400.00. Therefore, petitioners' Deposit Account will be charged the difference of \$70.00, as authorized. Furthermore, the \$400.00 petition fee is unnecessary and will applied to the amount due for filing the petition under 37 CFR 1.137(b). Accordingly, the Office will also charge the Deposit Account \$1,100.00 for the remaining balance of the petition fee.

The petition under 37 CFR 1.137(b) is granted.

This matter is being referred to the Office of Patent Publication for processing into a patent.

Telephone inquiries concerning the issuance of the application into a patent should be directed to the Office of Patent Publication, Customer Service at (703) 305-8497.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions